

SUPREME COURT OF THE UNITED STATES

Heyer, Doing Business as T.A. Heyer Duplicator Company v.
Duplicator Manufacturing Company

263 U.S. 100 (1923) · No. No. 75 · Decided November 12, 1923

SUMMARY

The Supreme Court considered whether purchasers of patented duplicating machines could replace worn gelatine bands with bands obtained from another source. It held that the purchasers had the right to replace the bands, so the respondent could not establish patent infringement based on the petitioner’s sale of compatible replacement bands, and reversed the decree.

CASE DETAILS

COURT	Supreme Court of the United States
WRITING FOR THE COURT	Oliver Wendell Holmes, Jr.
JURISDICTION	Federal
DECIDED	November 12, 1923
DOCKET	No. 75
DISPOSITION	reversed
PROCEDURAL POSTURE	The respondent patent owner brought a patent-infringement suit in equity. The District Court dismissed the bill, the Seventh Circuit reversed and entered a decree for the respondent, and the Supreme Court granted certiorari.
PRECEDENTIAL VALUE	Published United States Supreme Court opinion; precedential
PARTIES	Heyer, doing business as T.A. Heyer Duplicator Company v. Duplicator Manufacturing Company

TOPICS

- patent law
- patent infringement
- intellectual property
- commercial litigation

PRACTICE AREAS

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QUESTIONS PRESENTED

1. Whether purchasers of the patented copying machines had the right to replace exhausted gelatine duplicating bands with bands obtained from any source.
2. Whether a third party infringed the patent by making and selling replacement bands sized and mounted for use in the patented machines.

HOLDINGS

1. Purchasers of the machines had the right to maintain them in use by replacing the exhausted gelatine bands, including by obtaining replacement bands from sources other than the patentee.
2. Heyer's sale of replacement gelatine bands and spools for use in the patented machines did not infringe the patent because purchasers were entitled to obtain and use replacement bands from any source.

KEY QUOTATIONS

"Since Wilson v. Simpson, 9 How. 109, 123, it has been the established law that a patentee has not "a more equitable right to force the disuse of the machine entirely, on account of the inoperativeness of a part of it, than the purchaser has to repair; who has, in the whole of it, a right of use."" (263 U.S. 101)

"We cannot doubt what the fair interpretation is and it would not be affected even if every purchaser knew that the vendor was prepared to furnish new bands." (263 U.S. 102)

FACTUAL BACKGROUND

Duplicator Manufacturing Company owned a patent for improvements in multiple-copying machines, including a machine fitted with a gelatine duplicating band wound on a spool. Heyer made and sold replacement gelatine bands of sizes fitted for use in the patented machines and attached them to spindles, intending that purchasers use them as replacements. The bands were inexpensive, commonly available articles that were exhausted after limited use, while the machines themselves were durable and capable of indefinite use.

PROCEDURAL HISTORY

The District Court dismissed the infringement bill. The Circuit Court of Appeals for the Seventh Circuit entered a decree for Duplicator Manufacturing Company, with one judge dissenting on the principal issue. The Supreme Court reversed the appellate decree.

DISPOSITION

reversed

CASES CITED

- Wilson v. Simpson, 9 How. 109, 123, 126 (1851)
- Leeds & Catlin Co. v. Victor Talking Machine Co., 213 U.S. 325 (1909)